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Charles Eric Hunter

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EXAMINER

AUGUSTIN, EVENS J

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* CHARLES ERIC HUNTER  
9

10  
11 Appeal 2009-003103  
12 Application 09/476,078  
13 Technology Center 3600  
14

15  
16 Decided: January 25, 2010  
17

18  
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20  
21 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.  
22 FETTING, *Administrative Patent Judges*.

23  
24 CRAWFORD, *Administrative Patent Judge*.

25  
26  
27 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-25, 27 and 31-33. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented systems and methods for blanket transmitting video/audio content such as movies and music selections to each customer's computer-based recording, storage, and playback system. Customers preselect from a list of available movies, music, or other content in advance using an interactive screen selector, and pay for only the video/audio content that is actually viewed or music actually recorded for unlimited playback (Spec. 1:9-17).

Claim 1 under appeal is further illustrative of the claimed invention as follows:

1. A method comprising:

receiving unrestricted playback selection information regarding a previously recorded music content item from a station, said station being associated with a customer, said unrestricted playback selection information having been generated automatically upon determining that the previously recorded music content item has been played at least a predetermined number of times at the station;

granting permission for unrestricted playback of the previously recorded music content item; and

billing the at least one customer based on the unrestricted playback selection information received.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Schulhof  
Neville

US 5,572,442  
US 6,272,636 B1

Nov. 5, 1996  
Aug. 7, 2001

1 The Examiner rejected claims 1-9 and 32-33 under 35 U.S.C. § 101  
2 for failing to recite patentable subject matter; and rejected claims 1-25, 27,  
3 and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over Schulhof in  
4 view of Neville.

5 We AFFIRM.

6  
7 ISSUES

8 Did the Appellant show the Examiner erred in asserting that claims 1-  
9 9 and 32-33 do not recite patentable subject matter under 35 U.S.C. § 101?

10 Did the Appellant show the Examiner erred in asserting that a  
11 combination of Neville and Schulhof renders obvious receiving unrestricted  
12 playback selection information regarding a previously recorded music  
13 content item, the unrestricted playback selection information having been  
14 generated automatically upon determining that the previously recorded  
15 music content item has been played at least a predetermined number of  
16 times, as recited in independent claims 1, 10, 27, 31, and 32?

17  
18 FINDINGS OF FACT

19 *Specification*

20 Appellant invented systems and methods for blanket transmitting  
21 video/audio content such as movies and music selections to each customer's  
22 computer-based recording, storage, and playback, system. Customers  
23 preselect from a list of available movies, music or other content in advance  
24 using an interactive screen selector, and pay for only the video/audio content  
25 that is actually viewed or music actually recorded for unlimited playback  
26 (Spec. 1:9-17).

1           *Neville*

2           Neville discloses digital product production and distribution including  
3           distribution of digital products in an execution controlled form (col. 1, ll. 11-  
4           14).

5           A metering function is incorporated into a previously manufactured  
6           fully functional digital product (col. 6, ll. 27-29).

7           Following public distribution of the metered product 200', end users  
8           receive, in block 107, copies of the metered product 200' for evaluation by  
9           execution thereof on a given computing device (col. 7, ll. 11-15).

10          A metering function operates under the programming of code section  
11          402, e.g., allows a limited number of metered digital products 200'  
12          executions or allows product 200' execution only during a limited time  
13          period (col. 8, ll. 53-57).

14          Programming associated with decision block 607 determines  
15          according to some criteria, e.g., number of allowed executions or execution  
16          only during an allowed time period, whether the trial evaluation of metered  
17          digital product 200' remains in effect. If the trial evaluation is complete, the  
18          control passes to block 610 where meter code section 402 presents a  
19          message to the user indicating the trial evaluation has terminated and that  
20          purchase is now required to continue use (col. 9, ll. 42-50).

21          The server/clearinghouse 804 determines whether the user is  
22          authorized to execute the application and, if allowed, the server transmits the  
23          unlock key 803 to the end-user 806 computing device executing the client  
24          application. The client application makes use of unlock key 803 to decrypt  
25          previously encrypted portions, i.e., as encrypted by the builder program, and  
26          facilitate execution of the actual digital product. If the user is not to be

1 allowed use of this application, i.e., the server/clearinghouse 804 determines  
2 that an evaluation period has expired, the server does not transmit the unlock  
3 key 803 to the end user 806 computing device but sends an “end of  
4 evaluation” message (col. 13, ll. 23-35).

5  
6 PRINCIPLES OF LAW

7 *35 U.S.C. § 101*

8 The test to determine whether a claimed process recites patentable  
9 subject matter under § 101 is whether: (1) it is tied to a particular machine or  
10 apparatus, or (2) it transforms a particular article into a different state or  
11 thing. *In re Bilski*, 545 F.3d 943, 961-62 (Fed. Cir. 2008) (*en banc*).

12  
13 *Claim Construction*

14 While the specification can be examined for proper context of a claim  
15 term, limitations from the specification will not be imported into the claims.  
16 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir.  
17 2005).

18  
19 ANALYSIS

20 *Patentable Subject Matter*

21 We are persuaded of error on the part of the Examiner by Appellant’s  
22 argument that claims 1-9 and 32-33 do not recite patentable subject matter  
23 under 35 U.S.C. § 101 (Reply Br. 1-7). The Examiner asserts that “the  
24 information is not coming directly from the station such that the step does  
25 not require a tie to another statutory category” (Ex. Ans. 3). However,  
26 independent claims 1 and 32 recite numerous steps, for example, the billing

1 step in independent claim 1 and the transmitting step in independent claim  
2 32, which require a machine. Accordingly, claims 1-9 and 32 to 33 are tied  
3 to another statutory category.

4 The Examiner also asserts that “merely gathering . . . data with a  
5 machine [is] nominal” (Ex. Ans. 3). However, independent claims 1 and 32  
6 recite steps other than “merely gathering data,” for example, the  
7 aforementioned billing step in independent claim 1 and transmitting step in  
8 independent claim 32. Accordingly, the necessity of machines capable of  
9 performing steps in addition to “merely gathering data” makes them more  
10 than “nominal” recitations of a machine.

11  
12 *Unrestricted Playback Selection Information*

13 We are not persuaded of error on the part of the Examiner by  
14 Appellant’s argument that a combination of Neville and Schulhof renders  
15 obvious receiving unrestricted playback selection information regarding a  
16 previously recorded music content item, the unrestricted playback selection  
17 information having been generated automatically upon determining that the  
18 previously recorded music content item has been played at least a  
19 predetermined number of times, as recited in independent claims 1, 10, 27,  
20 31, and 32 (App. Br. 10-13; Reply Br. 7-8). Appellant argues that  
21 unrestricted playback selection information is automatically generated *solely*  
22 based upon determining that the previously recorded music content item has  
23 been played at least a predetermined number of times. However, such an  
24 aspect is not set forth in the claims. *See CollegeNet, Inc. v. ApplyYourself,*  
25 *Inc.*, 418 F.3d at 1231.

Schulhof discloses that after the user is notified that the limited number of executions in the trial evaluation of the metered digital product has expired, the user is prompted to purchase the metered digital product. Upon the user's affirmative purchase of the metered digital product, server/clearinghouse 804 automatically generates and transmits unlock key 803 to end-user 806 computing device executing metered digital product 200'. Unlock key 803 of Schulhof corresponds to the recited unrestricted playback selection information. The fact that Schulhof discloses the intervening affirmative purchase step of the user does not mean that unlock key 803 is no longer based on the number of executions in the trial evaluation; it is still based on that *in addition to* the user's affirmative purchase. Accordingly, we sustain the rejections of independent claims 1, 10, 27, 31, and 32.

As Appellant does not set forth any additional arguments concerning any errors made by the Examiner specific to the rejections of any of dependent claims 2-9, 11-25, and 33, these rejections are also sustained.

#### CONCLUSION OF LAW

On the record before us, Appellant has shown that the Examiner erred in rejecting claims 1-9, 32, and 33 under 35 U.S.C. § 101.

On the record before us, Appellant has not shown that the Examiner erred in rejecting claims 1-25, 27, and 31-33 under 35 U.S.C. § 103(a).

#### DECISION

The decision of the Examiner to reject claims 1-25, 27, and 31-33 is affirmed.



